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Paper No. 6

SWIDLER BERLIN SHEREFF FRIEDMAN, LLP
3000 K STREET, NW
BOX IP
WASHINGTON DC 20007

In re Application of
Flesner, Chaston, Anuff, Moses, MacLeod, Leiser, Muoto
Ladygo, Slesinsky, and Joyce
Application No. 09/886,614
Filed: June 22, 2001
Attorney Docket No. 19312.0015
For: PORTAL SERVER THAT PROVIDES MODIFICATION
OF USER INTERFACES FOR ACCESS TO COMPUTER
NETWORKS

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MAY 20 2002

OFFICE OF PETITIONS

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(b)

This is a decision on the petition under 37 CFR 1.47(a), filed February 21, 2002.

The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Failure to respond will result in the abandonment of this application. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a).

The above-identified application was filed on February 21, 2002, without an executed oath or declaration. Accordingly, a "Notice to File Missing Parts of Application" was mailed on August 21, 2001, requiring an executed oath or declaration, filing and claim fees, and a surcharge for the late filing of the oath or declaration.

On February 21, 2002, petitioner filed the instant petition and obtained a four (4) month extension of time to file a reply. In support of the petition, petitioner filed a "Combined Declaration and Power of Attorney" and the affidavit of Mr. Paul Loomis.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee,
- (4) a statement of the last known address of the non-signing inventor,

The instant petition lacks item (1) as set forth above.

As to item (1), petitioner did not provide adequate documentation that diligent efforts were made to locate the non-signing inventors. A standard of what will suffice as "adequate documentation" is found in *Manuel of Patent Examining Procedure*, Section 409.03(d) and provides, in pertinent part, as follows:

Where inability to find or reach a non-signing inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc. that support a finding that the non-signing inventor could not be found or reached should be part of the affidavit or declaration. It is important that affidavit or declaration contain statements of facts as opposed to conclusions.

Petitioner did not provide sufficient evidence of petitioner's, or other interested parties, efforts to locate the non-signing inventors. Petitioner only indicates that an inquiry was made to the Human Resources department of what is presumed to be the last known employer for the nonsigning inventors as to the addresses for the nonsigning inventors. Using the address provided by the employer, petitioner sent correspondence to the nonsigning inventors relative to the prosecution of the subject application. There is no evidence, however, that the address provided by the employer was accurate or that petitioner made any other effort to attempt to confirm delivery of the application papers to the nonsigning inventor, i.e., use of certified mail. Though petitioner did provide a copy of the FEDEX Airbill of the package sent to the nonsigning inventor, the airbill does not provide any evidence that the package was received by the nonsigning inventor. Sufficient evidence has not been provided to substantiate a claim that a "diligent effort" was made to present the nonsigning inventors with the application papers. Accordingly, petitioner has failed to satisfy item (1) above.

Also as to item (1) above, petitioner has not demonstrated that a complete copy of the application papers was presented to the nonsigning inventors. From the copies of the cover letters sent to the nonsigning inventors, it appears that only the declaration and an assignment were sent to the nonsigning inventors. In order to be considered grantable, a petition under 37 CFR 1.47(a) requires that a complete copy of the application papers, including the specification, abstract, claims, and drawings, be presented to the nonsigning inventors. Sufficient proof was not provided to establish that this was done, therefore; item (1) above has not been satisfied.

It is noted that petition fee of \$130.00 was charged twice, therefore; \$130.00 will be credited to deposit account 19-5127, in due course.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By FAX: (703) 308-6919
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 South Clark Place
 Arlington, Virginia

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy